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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,505	04/06/2001	Elliott P. Dawson	12056-2	7931
23676	7590	04/21/2004	EXAMINER	
SHELDON & MAK, INC 225 SOUTH LAKE AVENUE 9TH FLOOR PASADENA, CA 91101			TRAN, MY CHAU T	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/827,505	DAWSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MY-CHAU T TRAN	1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-16, 18, 19, 21-24, 28 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16, 18, 19, 28 and 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/6/04 has been entered.

### ***Status of Claims***

1. Applicant's amendment filed 11/24/03 and 12/17/03 is acknowledged and entered. Claims 29-34 have been canceled. Claims 11, and 18 have been amended. Claims 35-38 have been added.
2. Claim 17 is canceled by the amendment filed on 9/10/03.
3. Claims 20, and 25-27 are canceled by the amendment filed on 6/12/03.
4. Claims 1-10 are canceled by the amendment filed on 12/10/02.
5. This application is a continuation of 09/145,140 filed 8/28/1998, which is a divisional of 08/927,974 filed 9/11/1997.

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6. Claims 11-16, 18-19, 21-24, 28, and 35-38 are pending.
7. Claims 21-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed 12/10/02.
8. Applicant has elected the following species for the elected invention (Claims 11-16, 18-19, 21-24, 28, and 35-38):
  - i. Species E (type of cutting device): a microtome, claim 12.
  - ii. Species F (type of target-strands): a target substance embedded in a porous rod, claim 13.
  - iii. Species G (type of bundle of target-strands): proteins, claim 14.
  - iv. Species H ("stabilizing" material): epoxy, claim 18.
  - v. Species I (type of "incorporated" material): secondary enzyme, claim 28
9. New claims 35-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species (i.e. species I), there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed 12/10/02.
10. Claims 11-16, 18-19, and 28 are treated on the merit in this Office Action.

***Withdrawn Rejections***

11. In view of applicant's arguments, the rejection of claims 11-16, 18-19, and 28 under 35 USC 102(e) as anticipated by Stimpson (US Patent 6,037,186; filed 7/16/1997) has been withdrawn.

12. In view of applicant's arguments, the rejection of claims 11-16, 18-19, and 28 under 35 USC 103(a) as being unpatentable over Pinkel et al. (US Patent 5,690,894) and Stimpson (US Patent 6,037,186) has been withdrawn.

***New Rejections***

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11-16, 18-19, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over and Stimpson (US Patent 6,037,186) and Toms et al. (US Patent 5,787,572).

Stimpson discloses "a method to produce arrays of compounds for concurrent testing" (Abstract; col. 3, lines 47-54; col. 4, lines 22-34). "Two formats are described using porous rods or porous sheet materials. In both cases, a bundle is formed by radial compression of the rods or spiral wrapping of the sheet. A sheath is applied to the bundle and arrays are cut as slabs (col. 8,

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lines 7-13). Each synthesis or application step to create an array element is used to fabricate multiple arrays.” The array elements (target substances) comprise biological compounds such as nucleic acid and proteins (col. 3, lines 47-51). The rods comprise materials such as polystyrene or polypropylene (col. 10, lines 16-49). The array elements are attached to the rod (col. 4, lines 7-11) (target substances embedded in a porous rod). The location of the rods and array elements are noted by “marking” the rods (col. 11, lines 18-31). The thickness of the cut slabs is in the range of 0.2-1 mm thick (col. 12, lines 11-14) (refers to claims 15 and 16). The cutting is performed by either a microtome device or laser (col. 12, lines 12-17 and lines 42-54). The array elements can be labels with either direct or indirect labeling with enzymes (col. 11, lines 46-59) (refers to claims 19 and 28).

The method of Stimpson does not expressly disclose that the stabilizing the bundle by embedding it in a matrix.

Toms et al. disclose that it is known in the fibre bundle art “stabilized” the fiber bundle with a fixing matrix such as epoxy resin for cutting (col. 1, lines 7-13).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include embedding the bundle in a matrix as taught by Toms et al. in the method of Stimpson. One of ordinary skill in the art would have been motivated to include embedding the bundle in a matrix in the method of Stimpson since Toms et al. disclose it is known in the fiber bundle art to stabilized the fibers with a fixing matrix in order to cut the bundle fibers and Stimpson teaches using a sheath in order to protect the bundle for cutting (Stimpson: col. 8, lines 7-13; Toms: col. 1, lines 7-13). Furthermore, one of ordinary skill in the art would have reasonably expectation of success in the combination of Stimpson and Toms et al.

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because using the matrix to fix the bundle for cutting is a well establish methodology of the fiber bundle art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
April 19, 2004

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER